



PATENT
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

 July 27, 2004
Jane A. Walker Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 10/800,531
Conf. No.: 2309
Filed: March 15, 2004
Group Art Unit: 1616
Examiner: Unknown
Applicants: Achilefu et al.
Title: **RECEPTOR AVID EXOGENOUS OPTICAL CONTRAST
AND THERAPEUTIC AGENTS**
Atty Doc. No.: MRD-64CP

Cincinnati, Ohio 45202

July 27, 2004

Mail Stop MISSING PARTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**PETITION WITH STATEMENT OF FACTS IN SUPPORT OF FILING ON
BEHALF OF NONSIGNING INVENTOR
AND DECLARATION OF PROPRIETARY INTEREST (37 CFR §1.47)**

This Statement is made as to the pertinent facts that are relied upon to establish the diligent effort made to secure the execution of the Declaration by the nonsigning inventor, and to establish the proprietary interest of the entity to whom the application is to be assigned, for the above-identified patent application, based on the non-signing inventor's statements in another

application and, in general, his refusal to execute any applications without compensation.

Applicant respectfully requests grant of this Petition because the nonsigning inventor's refusal to execute the Declaration and Assignment without payment of consulting fees amounts to a refusal to sign, in view of the Assignee's policy not to compensate former employees for such tasks.

The Statement of Facts is being made by the available persons having first-hand knowledge of the facts recited therein. The Declaration is being made by an attorney at law familiar with the law of the jurisdiction and having first hand knowledge of the facts.

IDENTIFICATION OF PERSONS MAKING THE STATEMENT OF FACTS

Anthony R. Kinney, Esquire, Patent Attorney
Tammy Torres, Senior Intellectual Property Paralegal
Mallinckrodt Inc.
675 McDonnell Boulevard
St. Louis, Missouri 63134

IDENTIFICATION OF PERSON MAKING THE DECLARATION

Anthony R. Kinney, Esquire, Patent Attorney
Mallinckrodt Inc.
675 McDonnell Boulevard
St. Louis, Missouri 63134

LAST KNOWN ADDRESS OF THE NONSIGNING INVENTOR*

Samuel Achilefu, Ph.D.
3424 San Seville Court
St. Louis, Missouri 63044

*at the time the documents were originally provided

STATEMENT OF FACTS

The nonsigning inventor is a former employee of Mallinckrodt Inc., to whom the invention will be assigned. The nonsigning inventor's reason for refusing to sign the Declaration is Mallinckrodt's refusal of his request for compensation, in the form of consulting fees of \$150 per hour, for review and execution of formal documents. It is Mallinckrodt's policy not to compensate former employees for review and execution of documents to be submitted to the United States Patent and Trademark Office arising from their employment.

The following statement is supported by Attachment A, Memo from Anthony R. Kinney, Esquire, patent attorney for Mallinckrodt Inc. at the relevant time.

**STATEMENT OF FACTS BY
ANTHONY R. KINNEY, ESQUIRE**

I was the patent attorney for Mallinckrodt at the relevant time.

I called Dr. Achilefu, the nonsigning inventor, on March 5, 2004, regarding execution of the Declaration, Assignment, and Power of Attorney documents, already in Dr. Achilefu's possession for another pending U.S. Patent Application Serial No.10/680,338. I inquired about Dr. Achilefu's request to receive consulting fees for reviewing and executing these documents, and informed Dr. Achilefu that Mallinckrodt's policy was not to pay consulting fees for executing formal documents to inventors that were no longer employees.

Dr. Achilefu indicated that he was not refusing to execute these documents outright, but nevertheless would not execute these documents without being paid consultation fees for the time he spends reviewing and executing the paperwork.

I stated that Mallinckrodt must then file these documents with a Petition describing Dr. Achilefu's refusal to sign. Dr. Achilefu stated that he would file a letter in the Patent Office in order that his reasons for refusing to execute the declaration are on record.

Based on Dr. Achilefu's comments and position with regard to U.S. Patent Application Serial No.10/680,338, I did not further pursue his execution of the same documents for the current application.


Anthony R. Kinney, Esquire

6/3/04
Date

DECLARATION OF ANTHONY R. KINNEY, ESQUIRE

I, Anthony R. Kinney, declare as follows:

(1) I was the patent attorney for Mallinckrodt Inc. at the relevant time.

(2) The parent applications, U.S. Patent No. 6,395,257, and U.S. Serial Number 09/864,011, of the above-referenced application names four inventors: Samuel Achilefu, Raghavan Rajagopalan, Richard B. Dorshow, and Joseph E. Bugaj. The patent and application are assigned to Mallinckrodt Inc. The Assignment for the patent was executed when the application was filed on January 18, 2000, and is Recorded at Reel 10551, Frame 530. The Assignment for the pending application was executed when the application was filed on May 23, 2001, and is Recorded at Reel 11847, Frame 694-699. A corrective Assignment was executed on September 24, 2001, and is Recorded at Reel 12186, Frame 560-566

(3) The above referenced application is a Continuation-In-Part (U.S. Serial No. 10/800,531) of the parent application, which is a Continuation-In-Part of the issued patent. The Continuation-In-Part includes the above-named four inventors and adds Muthunadar P. Periasamy as an inventor. All of the inventors except Dr. Achilefu have assigned their rights in this invention to Mallinckrodt Inc.

(4) Mallinckrodt Inc. has a proprietary interest in the 10/800,531 application at least because of its relationship with the parent application, U.S. Patent No. 6,395,257 and U.S. Serial Number 09/864,011, assigned to Mallinckrodt.

(5) In my opinion, these facts support the conclusion that a court would award title to Mallinckrodt Inc.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the subject application or any patent issued thereon.

6/3/04
Date

Anthony R. Kimney
Anthony R. Kimney, Esquire

The following statement is supported by Attachments B and C
(Attachment B, February 17, 2004 e-mail from Dr. Achilefu to Tammy Torres;
Mallinckrodt's Senior Paralegal for Intellectual Property; Attachment C, February
27, 2004 e-mail from Tammy Torres to Dr. Achilefu, and Dr. Achilefu's February
29, 2004 response to Ms. Torres).

**STATEMENT OF FACTS BY
TAMMY TORRES**

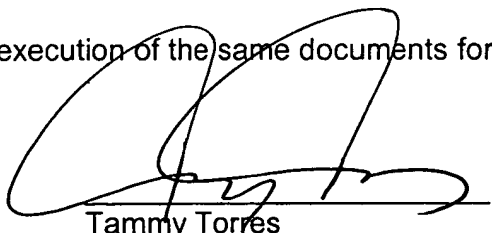
I am the Senior Paralegal for Intellectual Property at Mallinckrodt Inc.

On February 17, 2004, Dr. Achilefu indicated receipt of the Declaration and Assignment for another pending U.S. Patent Application Serial No.10/680,338, and his willingness to review and execute the documents. He stated that his consultation rate was \$150 per hour and questioned to whom he should bill his time or, alternatively, that notification of the filing status of the application would suffice so that his execution of the Declaration would not be required.

On February 27, 2004, I reminded Dr. Achilefu of the outstanding application, and requested his return of the executed documents by the due date.

On February 29, 2004, Dr. Achilefu indicated changed circumstances making his time "extremely valuable". While insisting that his actions were not a refusal to execute the Declaration, he nevertheless indicated that he would not do so without compensation.

As of March 29, 2004, Dr. Achilefu had not responded to our request to execute the documents. Based on Dr. Achilefu's comments and position with regard to U.S. Patent Application Serial No.10/680,338, no further attempts were made to pursue his execution of the same documents for the current application.



Tammy Torres



Date July 2, 2004

Enclosed is a check in the amount of \$130.00, the fee for submission of this Petition pursuant to 37 CFR §1.17(h). Applicant does not believe any other fee is due with this submission. However, if any other fees are deemed due, the Examiner is authorized to charge such fees to Deposit Account No. 30-2300.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

By: Beverly A. Lyman
Beverly A. Lyman, Ph.D.
Reg. No. 41,961

WOOD, HERRON & EVANS, L.L.P.
2700 Carew Tower
Cincinnati, Ohio 45202
513 241 2324
513 421 7269 - facsimile

Teleconference Memo
March 5, 2004
Case No. 1520.1

Subject: Teleconference With Dr. Samuel Achilefu regarding Signing Patent Documents

1. I spoke with Dr. Achilefu on March 5, 2004 about his execution of the declaration, assignment, and power of attorney documents for Case No. 1520.1 and its related foreign application. I informed Dr. Achilefu that I had inquired about his request that he receive consulting fees for reviewing and executing patent documents that are to be filed in the Patent Office. I further informed him that Mallinckrodt will not pay consulting fees to inventors that are no longer employees of the company for executing formal papers.
2. Dr. Achilefu stated that while he is not refusing to sign the paperwork outright, he will not sign the papers without being paid consultation fees for the time he spends reviewing and executing the paperwork.
3. I stated that Mallinckrodt would then have to file the documents with a petition describing Dr. Achilefu's refusal to sign the declaration. Dr. Achilefu stated that he would file a letter in the Patent Office in order that his reasons for refusing to execute the declaration are on record.

Anthony R. Kinney


ATTACHMENT "A"

-----Original Message-----

From: achilefus@mir.wustl.edu [mailto:achilefus@mir.wustl.edu]
Sent: Tuesday, February 17, 2004 9:16 AM
To: tammy.torres@tycohealthcare.com
Subject: Patent applications

Hi Tammy,

Life has been very busy here and I returned to St. Louis last week. I received the patent applications and related documents for my signature. I will be glad to review them and sign. Who should I bill my time for consultation on these activities? My rate is \$150.00/hour. I hate to sign things without reading them and it takes time to make sure that the documents are technically correct. Alternatively, I learnt that you can file the applications without all inventors signature. In that case, notifying me of the filing status will suffice.

Thanks,
Sam

*

Samuel Achilefu, PhD
Associate Professor of Radiology
Department of Radiology
Washington University School of Medicine
Campus Box # 8225
4525 Scott Avenue - East Building
St. Louis, MO 63110

achilefus@mir.wustl.edu
314 362 8599(voice)
314 790 5868 (pager)
314 747 5191 (fax)

ATTACHMENT "B"

To: "achilefus@mir.wustl.edu" <achilefus@mir.wustl.edu>
From: "Torres, Tammy A" <Tammy.Torres@TycoHealthcare.com>
Date: 02/27/2004 12:07PM
Subject: Patent case no. 1520.1 US "Novel Dyes for Organ Function Monitoring"

Would it be possible to get the signed documents signed, notarized and back to me by next Monday or Tuesday? They are due to the Patent office by March 5.

Tammy

Fax: 314-654-3156

ATTACHMENT "C"

From: "Kinney, Anthony R" <Anthony.Kinney@TycoHealthcare.com>
To: "Kinney, Anthony R" <Anthony.Kinney@TycoHealthcare.com>
Date: 3/8/2004 11:20:44 AM
Subject: RE: Patent case no. 1520.1 US "Novel Dyes for Organ Function Monitoring"

-----Original Message-----

From: achilefus@mir.wustl.edu [mailto:achilefus@mir.wustl.edu]
Sent: Sunday, February 29, 2004 8:52 PM
To: Torres, Tammy A
Cc: 'achilefus@mir.wustl.edu'; Boone, Jeffrey S
Subject: Re: Patent case no. 1520.1 US "Novel Dyes for Organ Function Monitoring"

Dear Tammy,

I understand your urgency in getting the documents signed and notarized. As you know, I have actively cooperated with Mallinckrodt, Inc. to expedite these matters in the past. On some occasions, I personally hand-delivered the executed documents to you in person. In all these times, I have not asked Mallinckrodt to compensate me for my time. However, things have changed and my time is extremely valuable these days. Particularly, if I have to spend family time performing any work outside my current responsibilities at Washington University or career-related activities, I request that I be compensated for my time.

Patent applications are legal documents and you have asked me to review and them for accuracy and completeness before signing. Additionally, I will be acknowledging that I have reviewed and understood the contents of the applications when I sign them. For legal reasons, I have to satisfy these requirements and it simply takes time. In the past, I have spent personal time reviewing similar documents without asking for compensation but I want everyone to respect my time. What you ask me to do falls under consultation.

Please note that I am NOT REFUSING to sign but insist that I be paid for my time, based on principle. If you agree to this condition, please advise so that I can work on the documents Monday night and return them to you on Tuesday.

Samuel Achilefu

Samuel Achilefu, PhD
Associate Professor of Radiology
Department of Radiology
Washington University School of Medicine
Campus Box # 8225
4525 Scott Avenue - East Building
St. Louis, MO 63110

achilefus@mir.wustl.edu
314 362 8599(voice)
314 790 5868 (pager)
314 747 5191 (fax)



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Jane A. Walker
Jane A. Walker

July 27, 2004
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Attorney Reference No.: MRD-64CP

Cincinnati, Ohio 45202

July 27, 2004

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**ADDED PAGE TO REVISED DECLARATION, POWER OF ATTORNEY AND
PETITION FOR SIGNATURE BY JOINT INVENTORS
ON BEHALF OF NONSIGNING INVENTOR WHO REFUSES
TO SIGN OR CANNOT BE REACHED (37 CFR §1.47(a))**

I. I am an above named joint inventor and have signed this Declaration on my own behalf and also sign this Declaration under 37 CFR§1.47(a) on behalf of the joint inventor who refuses to sign, particulars for whom are:

Full name of first Samuel Achilefu

nonsigning inventor who

(√) refuses to sign

Country of Citizenship of first nonsigning inventor USA

Last known address of first nonsigning inventor

(1) PETITION WITH STATEMENT OF FACTS IN SUPPORT OF FILING
ON BEHALF OF NONSIGNING INVENTORS

(2) THE PETITION FEE OF \$130.00 (37 CFR §1.17(h))

P. Narayan Rajagopalam
Signature

Signature

Signature

Signature

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Country of Citizenship of first nonsigning inventor USA

3424 San Seville Court, St. Louis, Missouri 63044
Last known address of first nonsigning inventor

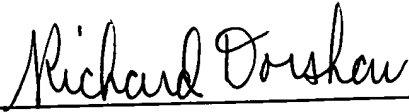
II. Accompanying this declaration is:

- (1) PETITION WITH STATEMENT OF FACTS IN SUPPORT OF FILING
ON BEHALF OF NONSIGNING INVENTORS
- (2) THE PETITION FEE OF \$130.00 (37 CFR §1.17(h))

Raghavan Rajagopalan
*Name of joint inventor signing on
behalf of nonsigning inventor*

Signature

Richard B. Dorshow
*Name of joint inventor signing on
behalf of nonsigning inventor*


Signature

Joseph Bugai
*Name of joint inventor signing on
behalf of nonsigning inventor*

Signature

Muthunadar P. Periasamy
*Name of joint inventor signing on
behalf of nonsigning inventor*

Signature

() cannot be found or reached

Country of Citizenship of first nonsigning inventor USA

3424 San Seville Court, St. Louis, Missouri 63044

Last known address of first nonsigning inventor

II. Accompanying this declaration is:

- (1) PETITION WITH STATEMENT OF FACTS IN SUPPORT OF FILING
ON BEHALF OF NONSIGNING INVENTORS
- (2) THE PETITION FEE OF \$130.00 (37 CFR §1.17(h))

Raghavan Rajagopalan
*Name of joint inventor signing on
behalf of nonsigning inventor*

Signature

Richard B. Dorshow
*Name of joint inventor signing on
behalf of nonsigning inventor*

Signature

Joseph Bugaj
*Name of joint inventor signing on
behalf of nonsigning inventor*



Signature

Muthunadar P. Periasamy
*Name of joint inventor signing on
behalf of nonsigning inventor*

Signature

() cannot be found or reached

Country of Citizenship of first nonsigning inventor USA

3424 San Seville Court, St. Louis, Missouri 63044

Last known address of first nonsigning inventor

II. Accompanying this declaration is:

(1) PETITION WITH STATEMENT OF FACTS IN SUPPORT OF FILING
ON BEHALF OF NONSIGNING INVENTORS

(2) THE PETITION FEE OF \$130.00 (37 CFR §1.17(h))

Raghavan Rajagopalan

*Name of joint inventor signing on
behalf of nonsigning inventor*

Signature

Richard B. Dorshow

*Name of joint inventor signing on
behalf of nonsigning inventor*

Signature

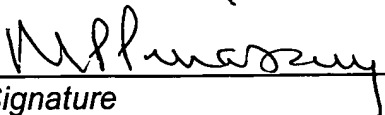
Joseph Bugaj

*Name of joint inventor signing on
behalf of nonsigning inventor*

Signature

Muthunadar P. Periasamy

*Name of joint inventor signing on
behalf of nonsigning inventor*



Signature